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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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12/10/02

In re Application of	)	
	)	
Shou-Wei DING	)	Examiner: Georgia L. Helmer
	)	
Serial No. 09/700,113	)	Group Art Unit: 1638
	)	
Filed: February 16, 2001	)	

For: DISEASE RESISTANT TRANSGENIC PLANTS

ELECTION AND RESPONSE

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

In response to the restriction requirement mailed October 3, 2002, Applicant submits the following election, with traverse, and remarks.

The Patent Office has found the present application to encompass four inventions:

I. Claims 1-9, 18, 19 and 20, drawn to transgenic plants containing a cucumovirus 2b gene;

II. Claims 10-17, 21-23 and 30-34, drawn to a method of making a plant resistance to disease by using a cucumovirus 2b gene;

III. Claims 24-26, and 30-37 drawn to transgenic plants containing a two-domain Avr gene;

IV. Claims 27-29, drawn to a method of making a plant resistant to disease by using a two-domain Avr gene.

The Applicant respectfully traverses this grouping of the claims, and proposes an alternative grouping, for the following reasons. The Patent Office has asserted that the inventions of Group I and II are unrelated because "[t]he plants made by invention II are disease resistant plants whereas the plants of I are not." Paper 9 at 3. Applicant respectfully submits that this assertion is erroneous. It is the presence of the cucumovirus 2b gene which confers disease resistance to the plant, therefore the plants of Group I are in fact disease resistant. It is not clear whether the Examiner is applying the rules for domestic applications (37 CFR §1.141-1.146), or those for national stage filings of international applications (37 CFR §1.475 and 1.499), however under either set of rules the requirement is improper. 37 CFR §1.141(b) states that

> "Where claims to all three categories, product, process of making, and process of use, are included in a national application, a three-way requirement for restriction can only be made where the process of making is distinct from the product. If the process of making and the product are not distinct, the process of using may be joined with the claims directed to the product, and the process of making the product even though a showing of distinctness between the product and process of using the product can be made."

37 CFR §1.475(b) states that:

> "An international application or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:
>
> (1) A product and a process specially adopted for the manufacture of said product . . ."

As stated above, the distinction between the inventions of Group I and Group II that is alleged by the Patent Office does not, in fact, exist. These groups therefore, are related as product and process of making the product, and therefore should be

grouped together.

The Patent Office has asserted that the inventions of Groups III and IV, though related as process of making and product made, are distinct because "the plant can be made disease-resistant by introduction of mRNA." Paper 9, page 4. Applicant respectfully submits that this assertion is erroneous. Claims 24-26 recite "a transgenic plant stably transformed with a two-domain Avr gene;" these plants therefore contain DNA encoding the two-domain Avr protein, linked to a promoter. The methods of claims 27-29 recite as a positive process step "stably transforming the plant with a two-domain Avr gene," which does not include introduction of the mRNA, because that does not result in stable transformation. The asserted basis for distinctness between the groups, therefore, does not exist and Applicant respectfully submits that the inventions of Group III and IV should be grouped together.

For the foregoing reasons, Applicant suggests the following two-way restriction:

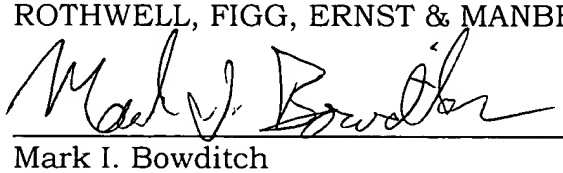
Group I comprised of claims 1-23

Group II comprised of claims 24-37.

Should the Applicant's proposed grouping of the claims be accepted, proposed Group II is hereby elected. If Applicant's proposed grouping of the claims is not accepted, Applicant provisionally elects original Group III. This provisional election of Group III is made with traverse for the reasons stated above.

Respectfully submitted,

ROTHWELL, FIGG, ERNST & MANBECK, p.c.

By 

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